

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Larry A. Gilbertson

Patent No.: 7,575,917 (Appln. No: 10/821,711)

Issued: August 18, 2009 (Filed: April 8, 2004)

For: DNA CONSTRUCTS AND METHODS TO
ENHANCE THE PRODUCTION OF
COMMERCIALY VIABLE TRANSGENIC
PLANTS

Group Art Unit: 1638

Examiner: David H. Kruse


Atty. Dkt. No.: MONS:140US

Conf. No. 1699

**CERTIFICATE OF ELECTRONIC TRANSMISSION
37 C.F.R. § 1.8**

I hereby certify that this correspondence is being electronically
filed with the United States Patent and Trademark Office via EFS-
Web on the date below:

May 13, 2010
Date


Marshall P. Byrd

**RESPONSE TO (1) DECISION ON REQUEST FOR RECONSIDERATION OF PATENT
TERM ADJUSTMENT; AND (2) DECISION ON REQUEST FOR RECALCULATION
OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

On April 13, 2010 the Office of Petitions mailed a Decision on the Request for Reconsideration of Patent Term Adjustment (the "Decision on Petition") filed by Applicants on October 16, 2009. Subsequently, on April 21, 2010, the PTO mailed a Decision on the Request for Recalculation of Patent Term Adjustment in View of *Wyeth* (the "*Wyeth* Decision") filed by Applicants on February 5, 2010. However, both Decisions indicate incorrect values for the PTA on the patent and thus Applicants hereby request appropriate correction as set forth below.

FACTUAL BACKGROUND

U.S. Patent No. 7,575,917 issued on August 18, 2009 and received a patent term adjustment of 312 days. On October 16, 2009 Applicants filed a Request for Reconsideration of Patent Term Adjustment (PTA) noting that correct PTA should be 777 days. On February 5, 2010 Applicants additionally filed a Request for Recalculation of PTA in View of *Wyeth*. The PTO mailed decisions on the two requests on April 13, 2010 and April 21, 2010, respectively. However, the PTA calculations set forth in each the decisions are incorrect, as detailed below.

RESPONSE AND REQUEST FOR CORRECTION

The Decision on Petition indicated that the PTA awarded to the patent should be 778 days. However, the PTO erred by awarding one extra day of PTA. Applicants detailed the correct calculation for the PTA in the Request for Reconsideration of PTA, which is attached hereto as Exhibit A. Specifically, the PTO calculation indicated an Applicant delay period of 71 days between 1/14/2009 and 3/26/2009 corresponding to the filing of a Supplemental Response to Office Action. However, the indicated Supplemental Response was filed on 3/27/2009 as shown in the attached filing receipt (Exhibit B) and the delay period should therefore be 72 days. Accordingly the correct PTA for the patent should be 777 days.

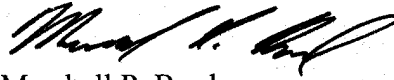
Likewise, the *Wyeth* Decision mailed on April 21, 2010 awarded an incorrect PTA of 1244 days. This calculation includes the same one-day error as the calculation in the Decision on Petition outlined above and appears also to have added the 466 days of "B" delay twice to arrive at the indicated PTA.

In view of the foregoing, the PTA for U.S. Patent No. 7,575,917 should be 777 days and appropriate correction is respectfully requested.

This Response is timely filed within one month of the Decision on Petition mailed on April 13, 2001 and no fees are believed due in connect with this paper. However if it is determined that any additional fees are due, the Commissioner is authorized to deduct said fees from *Sonnenschein Nath & Rosenthal* Deposit Account No.: 19-3140/MONS:140US.

Sonnenschein Nath & Rosenthal L.L.P.
2000 McKinney, Suite 1900
Dallas, Texas 75201
(214) 259-1860

Respectfully submitted,



Marshall P. Byrd
Reg. No. 62,454
Agent for Applicant

Date: May 13, 2010

EXHIBIT A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Larry A. Gilbertson

Patent No.: 7,575,917 (Appln. No: 10/821,711)

Issued: August 18, 2009 (Filed: April 8, 2004)

For: DNA CONSTRUCTS AND METHODS TO
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**CERTIFICATE OF ELECTRONIC TRANSMISSION
37 C.F.R. § 1.8**

I hereby certify that this correspondence is being electronically
filed with the United States Patent and Trademark Office via EFS-
Web on the date below:

October 16, 2009
Date

/Marshall P. Byrd/
Marshall P. Byrd

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. §1.705(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition under 37 C.F.R. §1.704(d) to correct an error in patent term adjustment (PTA) for the above referenced U.S. patent. Specifically, the U.S. Patent and Trademark Office (PTO) erred in calculating that the patent is entitled to only 312 days of PTA. In accordance with 35 U.S.C. 154(b), the patent is entitled to 777 days of PTA as detailed below. This request is timely filed within two months of the issuance of the subject patent.

REMARKS

U.S. Patent No. 7,575,917 received a patent term adjustment of 312 days. However, Applicants' calculations indicate that the actual term should be 777 days. A timeline is included herewith in support of these calculations. Specifically, it appears that the PTO failed to account for prosecution delays under both 35 U.S.C. §154(b)(1)(A) "A delay," which guarantees prompt PTO responses, and 35 U.S.C. §154(b)(1)(B) "B delay," which guarantees no more than 3 years of application pendency.

As indicated in the attached timeline, total PTO "A delay" was 474 days beginning 14-months after the filing of the application on 6/8/2005 and ending on 9/25/2006 when the first Office Action was issued. Total PTO "B delay" was 466 days beginning on 4/9/2007 after the application had been pending for three years and ending on 7/18/2008 when a Request for Continued Examination was filed. The A and B delays on the part of the PTO did not overlap and should be counted cumulatively. See, *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 88 USPQ 2d 1538 (D.D.C., September 30, 2008). Thus, total PTA for the patent should be calculated by adding PTO "A delay" time (474 days) plus PTO "B delay" time (466 days) and subtracting Applicants' delay time (163 days), for a total of 777 days of PTA. The instant patent application was not subject any specific expiration date by terminal disclaimer. Accordingly, Applicants respectfully request that the PTA indicated in the issued U.S. Letters Patent be amended to indicate 777 days.

The instant request is submitted along with the fee prescribed under 37 C.F.R. §1.18(e) and provides all factual information stipulated by 37 C.F.R. §1.705(b)(2). Should it be determined that any additional fees are due in connection with this request, the Commissioner is authorized to deduct said fees from *Sonnenschein Nath & Rosenthal* Deposit Account No.: 19-3140/MONS:140US.

Sonnenschein Nath & Rosenthal L.L.P.
2000 McKinney, Suite 1900
Dallas, Texas 75201
(214) 259-1860

Respectfully submitted,
/Marshall P. Byrd/
Marshall P. Byrd
Reg. No. 62,454
Agent for Applicant

Date: October 16, 2009

Patent Term Adjustment Time Line
U.S. Patent No. 7,575,917
Attorney Docket No. MONS:140US

Adjustment Under 35 U.S.C. 154(b)(1)(A)

Document	Date	Applicant Effect on Patent Term (# of Days)	PTO Effect on Patent Term (# of Days)
Application Filed	04/08/2004		
Restriction Requirement (R.R.)	09/25/2006		+474
Response to R.R.	10/24/2006		
Office Action (O.A.)	01/25/2007		
Response to 01/25/2007 O.A.	06/25/2007	-61	
Office Action	09/07/2007		
Response to 09/07/2007 O.A.	12/07/2007		
Final Office Action (F.O.A.)	03/18/2008		
Response to 03/18/2008 F.O.A.	07/18/2008	-30	
Office Action	10/14/2008		
Response to 10/14/2008 O.A.	01/14/2009		
Supplemental Response	03/27/2009	-72	
Notice of Allowance	04/10/2009		
Issue fee paid	07/10/2009		
Patent issues	08/18/2009		
Total		-163	+474

Adjustment Under 35 U.S.C. 154(b)(1)(B)

Application Filed	04/08/2004		
Request for Continued Examination	07/18/2008		+466
Total			+466

EXHIBIT B

Electronic Acknowledgement Receipt

EFS ID:	5051506
Application Number:	10821711
International Application Number:	
Confirmation Number:	1699
Title of Invention:	DNA constructs and methods to enhance the production of commercially viable transgenic plants
First Named Inventor/Applicant Name:	Larry A. Gilbertson
Customer Number:	73905
Filer:	Ron J. Laby
Filer Authorized By:	
Attorney Docket Number:	MONS:140US
Receipt Date:	27-MAR-2009
Filing Date:	08-APR-2004
Time Stamp:	16:38:16
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$400
RAM confirmation Number	2148
Deposit Account	
Authorized User	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
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1		MONS140US_suppl_resp.pdf	43486 e88982c9083763ed78feca268809e44f175501c7	yes	7
Multipart Description/PDF files in .zip description					
	Document Description	Start	End		
	Supplemental Response or Supplemental Amendment	1	2		
	Claims	3	5		
	Applicant Arguments/Remarks Made in an Amendment	6	7		
Warnings:					
Information:					
2	Information Disclosure Statement Letter	MONS140USsidsltr.pdf	82971 182f966ed2ee16be1b3f6d62a6a771591456693f	no	2
Warnings:					
Information:					
3	Information Disclosure Statement (IDS) Filed (SB/08)	MONS140USsidsfld.pdf	89859 ebf4b9e3a806a332fcbab64cccc3352e18c8c71	no	1
Warnings:					
Information:					
This is not an USPTO supplied IDS fillable form					
4	Foreign Reference	WO09714807A1.pdf	2415958 54c19ec381bc633cdebb85e61c413c46124e01a9	no	62
Warnings:					
Information:					
5	Fee Worksheet (PTO-06)	fee-info.pdf	31722 4d98ba103ec0c56040752768b11e72ab93bfbx07	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			2663996		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.